2-18-04

AF/3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	: Arnaud Capitant et al.	Appeal No. 24
Appln. No.	: 09/332,489	
Filed	: June 14, 1999	Group Art Unit: 3621
Title	: PROCESS FOR MAKING REMOTE PAYMENTS FOR THE PURCHASE OF GOODS AND/OR A SERVICE THROUGH A SYSTEM AND MOBILE RADIOTELEPHONE	Examiner: Backer, Firmin
Docket No.	: S828.312-0002	

REPLY BRIEF FOR APPELLANT

MS Appeal Brief-Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SENT VIA EXPRESS MAIL
Express Mail No.: EV 302265975 US

Sir:

This is a Reply Brief under 37 CFR §1.193(b)(1) in reply to an Examiner's answer dated January 14, 2004, of an Appeal from an Office Action dated April 4, 2003 in which claims 1-22 were finally rejected, based upon a Notice of Appeal filed September 29, 2003.

In response to Appellant's arguments addressed in the Appeal Brief, the Examiner raised several issues that should be discussed in more detail. Firstly, the Examiner began the response to Appellant's arguments by stating:

> First and foremost, Appellants disclose an inventive concept of 'identification of the buyer by the management center and/or the payment center and/or a control center based on a request from the supplier within the open network.' Given the manner in which the claim is written, and its interpretation, the phrase 'based on a request from the supplier within the open network' is considered part of the third option. Therefore, the identification can be done by any of the options listed and the third option which is argued, is not needed in order for the inventive concept to be operable.

Appellant respectfully points out that this is the first time that the Examiner has brought forth this interpretation, as it was neither made in the first Office Action mailed on September 23, 2002 nor in the Final Office Action mailed on April 1, 2003. As such, Appellant has neither had the chance to explain or amend the claims to conform its interpretation with that of the Examiner's. Moreover, this type of reasoning is more supportive of a rejection based upon 35 U.S.C. §112, second paragraph, as opposed to supporting a 35 U.S.C. §103(a) obviousness rejection. Because this issue was not raised in either the first Office Action or the Final Office Action, Appellant believes this to be an implicit new rejection based upon new grounds, and therefore in contradiction to 37 CFR §1.193(a)(2). In any event, this interpretation of the invention contradicts the plain language of the claim, and is not proper.

Next, the Examiner mischaracterizes Appellant's position by stating "[a]lthough applicant conceded that Fougnies discloses a concept of purchasing access time, Appellant argue that access time cannot be considered as good/services." Appellant respectfully asserts that it has not argued that access time alone cannot be considered as a good/service. As stated at page 9 of Appellant's Brief, Fougnies '851 does not disclose or suggest using a cellular telephone to make purchases of anything other than more telephone access time on the cellular telephone network. Thus, Fougnies '851 has nothing at all to do with permitting the cellular telephone user to purchase separate goods or services. As was argued in Appellant's Brief, additional telephone access time cannot be considered a separate good or service, because the cellular telephone user would not be a cellular telephone user in the first place without purchasing access time (i.e., the purchase of cellular telephone access time is subsumed in the definition of cellular telephone user). Therefore, Fougnies '851 has nothing at all to do with permitting the cellular telephone user to purchase anything from a third party. Fougnies '851 has nothing at all to do with permitting the cellular telephone user to purchase anything on an open-type network.

Finally, nowhere in the Examiner's Answer is there found language that would suggest to combine the teachings of the Fougnies patent with those of the Wagner patent. As stated in the Appeal Brief,

> "To establish a prima facie case of obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

See M.P.E.P. §2142. Just as the Office Action points to no language in either the Fougnies patent or the Wagner patent teaching or suggesting a basis for making such a combination, the Examiner's Answer also does not contain such language. Instead, the Examiner states, "[i]n this case, the teaching of Fougnies and Wagner are closely related and the combination of the teaching would have been obvious for one of ordinary skill in the art." There is no language in either the Fougnies patent or the Wagner patent cited, or a description of other knowledge generally available in the art, to support such a position. Thus, a prima facie case of obviousness has not been shown.

CONCLUSION

The present invention is directed to a method or process for making secure remote payments for the purchase of goods and/or services (from an open network) via a mobile phone (connected through a closed type radiocommunications network). The elements of the present invention are not taught, suggested, or disclosed by either the Fougnies patent or the Wagner patent. Moreover, there is no suggestion or motivation to combine the two references within their disclosures. The only motivation to make such a combination comes from the disclosure of the present invention, and the combination is nothing more than a hindsight reconstruction based on the Applicant's disclosure. Therefore, the rejection of claims 1-22 under 35 U.S.C. §103(a) is inappropriate and should be withdrawn.

Respectfully submitted,

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Sir:

The following papers are being transmitted via **EXPRESS MAIL** to the U.S. Patent and Trademark Office on the date shown below:

1. Itemized Return Receipt Postcard
2. Reply Brief for Appellant (3 pages)

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 2/17/04

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